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In the United States Patent and Trademark Office

In re the Application of:

Janani Janakiraman)

Serial Number: 09/994,518)

Group: 3625

Docket Number: AUS920010653US1)

Examiner: Yogesh C. Garg

Filed on: 08/31/2001)

For: "Dynamic Content Configuration)

for Microbrowsers by State, Resource)

Allocation and User Preferences")

APPEAL BRIEF

Real Party in Interest per 37 CFR §41.37(c)(1)(i)

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)

None.

Status of Claims per 37 CFR §41.37(c)(1)(iii)

Claims 1 - 21 are currently withdrawn from consideration responsive to a restriction requirement. Claims 22 - 29 are finally rejected, the rejections of which are appealed.

Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)

An amendment to Claims 22, 28 and 34 to present them in better condition for consideration on Appeal was submitted on April 26, 2007. This amendment corrected a typographical error and a terminology synonym consistency issue.

Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)

The present invention provides a method and system for extending the battery life of mobile web browsing device, such as a personal digital assistant (PDA) or cell phone, by detecting when the mobile device's battery is low, and then restricting the downloading of web page objects to avoid downloading "non-essential" web objects. By eliminating the downloading of non-essential web objects, power usually consumed by the receiver circuit to receive those non-essential web objects is reduced, thereby allowing extended life of the battery without substantial detrimental impact to the user of the information downloaded.

Independent claim 22 sets forth a method according to the invention:

- (a) providing a web server (*para. 0035*) with at least two sets of web objects for a web page (*para. 0043; fig. 3 #31, #32*), including at least one of set of web objects having been previous designated (*index "I" of para. 0043; fig. 3 #36*) as "essential" objects (*exemplified in paras. 0043 - 0048 as advertising and non-advertising "page content" objects; "essential" term was present in the claims as originally filed and thus is part of the original specification*);
- (b) receiving by said web server a battery condition from a networked client device (*paras. 0033 - 0034, 0038 - 0040, 0047*);
- (c) selecting only said essential web objects if said battery condition is low, otherwise selecting all of the web objects (*para. 0047; fig. 5 #51*); and
- (d) transmitting said selected web objects from said web server to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery (*para. 0048; fig. 5 #52*).

Independent claim 28 sets forth a computer readable medium encoded with software for performing the method according to the invention:

- (a) providing a web server (*para. 0035*) with at least two sets of web objects for a web page (*para. 0043; fig. 3 #31, #32*), including at least one of set of web objects having been previous designated (*index "I" of para. 0043; fig. 3 #36*) as "essential" objects (*exemplified in paras. 0043 - 0048 as advertising and non-advertising "page content" objects; "essential" term was present in the claims as*

originally filed and thus is part of the original specification);

- (b) receiving by said web server a battery condition from a networked client device (*paras. 0033 - 0034, 0038 - 0040, 0047*);
- (c) selecting only said essential web objects if said battery condition is low, otherwise selecting all web objects (*para. 0047; fig. 5 #51*); and
- (d) transmitting said selected web objects from said web server to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery (*para. 0048; fig. 5 #52*).

And, independent claim 34 sets forth a system having:

- (1) at least two sets of web objects (*para. 0043; fig. 3 #31, #32*) provided to a web server (*para. 0035*), said sets comprising at least one set previously designated (*index "I" of para. 0043; fig. 3 #36*) as essential objects (*exemplified in paras. 0043 - 0048 as advertising and non-advertising "page content" objects; "essential" term was present in the claims as originally filed and thus is part of the original specification*);
- (2) a battery condition receiver associated with said web server and configured to receive said battery condition from said networked client device (*paras. 0033 - 0034, 0038 - 0040, 0047*);
- (3) an object selector configured to select only essential web objects if said battery condition is low, otherwise selecting all of the web objects (*para. 0047; fig. 5 #51*); and
- (4) an object transmitter configured to transmit said selected web objects to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery (*para. 0048; fig. 5 #52*).

Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)

Review by the Board is respectfully requested of:

- (A) the rejections of Claims 22 - 34 under 35 U.S.C. §112, first paragraph;
- (B) the rejections of Claims 22 - 39 under 35 U.S.C. §112, second paragraph;
- (C) the rejections of Claims 22 - 39 as being unpatentable over U.S. Patent 6,493,6758 to McLain (hereinafter "McLain") in view of US Patent 6,108,316 to Agarwal *et al.* (hereinafter "Agarwal").

Arguments per 37 CFR §41.37(c)(1)(vii)**Rejections of Claims 22 - 34 under 35 U.S.C. §112, First Paragraph**

In the Final Office Action, Claims 22 - 34 were rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement with respect to the step "providing a web server with at least two sets of web objects for a web page including at least a set of web objects previously designated as essential objects". According to the examiner's rationale, the Appellants' disclosure "does not teach or suggest" web objects which are "previously designated" either by a human or the system (Final Office Action at pg. 7 line 7), and thus the disclosure does not convey that the Appellants were in possession of the invention at the time of filing the patent application.

Appellants' process through which web objects are designated or determined to be essential or non-essential achieved is, in part, accomplished through use of an index "I" (fig. 3 #36), which "may be built and populated manually, or preferably, by an analysis tool which generates these associated characteristics" (see last sentence of paragraph 0043).

When a web server tries to fulfill a page request from a mobile client, this index of objects is actively compared to an "Ad Configuration Data Set", or "ACD" (see Table 1, page 13 for example ACD) during the object selection and object blocking decision process. The ACD can be a plain text file (see para. 0039), is stored on the microbrowser device (para. 0038), and is provided from the microbrowser to the server along with the page request (para. 0044).

Thus, the user of the microbrowser device defines which objects are essential or non-essential (e.g. advertisement or non-advertisement) in his or her own opinion or preference by configuring his or her own plain-text Ad Configuration Data Set on his or her own microbrowser

device (see para. 0033 "allowing the user to configure which types of objects are not to be downloaded by the microbrowser including parameters . . . such as . . . battery conditions . . .").

If the examiner's holding relates more to whether or not the web objects were previously designated (e.g. a question of *sequence* of events), the claims specify the step of "providing" the previously-designated web objects, followed by recitation of steps of "receiving" a battery condition from the mobile client, then "selecting" essential web objects, and finally "transmitting" the selected web objects. According to the disclosure, and figures, the "selection" step includes the sub-steps of comparing the ACD to the index I, and it is performed subsequent to the web server being supplied with the index, the web objects, as well as subsequent to the microbrowser being provided with the user-defined ACD.

Therefore, Appellants' disclosure provides sufficient disclosure to convey that the Appellants were in possession of the claimed invention at the time of filing the patent application, in compliance with 35 U.S.C. §112, first paragraph. Appellants respectfully request reversal of the rejections of Claims 22 - 34 under 35 U.S.C. §112, First Paragraph.

Rejections of Claims 22 - 39 under 35 U.S.C. §112, Second Paragraph

In the Final Office Action, newly issued rejections of Claims 22 - 39 under 35 U.S.C. §112, second paragraph, were made for lack of antecedent basis for the term "said advertisement" web object set, which appears in independent claims 22, 28, and 34.

Advertisement web objects were disclosed, as consistently argued as being as examples of "non-essential" web objects, with the function of the invention being to block transmission of such advertisements during periods of client low battery conditions.

The amendment filed on September 13, 2006, inadvertently inserted the term "advertisement" instead of "non-essential". However, Appellants' arguments were correctly stated, in which advertisements were described as an example of non-essential web objects.

To place these claims in a clearer light for consideration on Appeal, Appellants filed an amendment on April 26, 2007, which deletes separate language to essential and non-essential (or advertisement) web object sets in this step of the claims, sufficing with "all said web objects". In other words, if the battery is not low, no web objects are blocked from transmission.

This is consistent with Appellants' previous reply arguments to the examiner, and thus does not redirect the examination to limitations, steps, or elements not previously presented in

the claims. Appellants have respectfully requested entry of the amendment in order to allow the Appeal to focus on the other issues of merit.

Rejections of Claims 22 - 39 under 35 U.S.C. 103(a) over McLain in view of Agarwal

In the Office Action prior to Final Office Action, claims 22 - 39 were rejected over a proposed combination of McLain and Agarwal. It was stated in the rationale for the rejections that McLain does not teach receipt by a server of a low battery condition from the client device (pg. 10), so it was proposed Agarwal's teaching of receipt of a battery condition and taking some sort of response to the low battery condition would have been obvious to combine with McLain's teaching.

It was summarized by the examiner that combining McLain with Agarwal would yield a server system which would receive a low battery condition and would *prioritize* web objects for transmission to the client under low battery conditions "before the battery becomes dead."

However, Appellants pointed out that prioritization of web objects for transmission (e.g. changing the order in which they are transmitted) is not the same operation of Appellants' system or claims (e.g. blocking the transmission of certain web objects):

- (A) Applicants' claims are directed towards methods for restricting the information transmitted from a server to a mobile device based upon battery level, which is a time varying condition. McLain's technology, however, is directed towards restricting the information transferred to a mobile device based upon a non-variable condition, namely memory capacity. Memory capacity would not change over time for a particular device, and thus McLain would not contain a suggestion to adapt or modify to determine which information objects to transfer based upon a variable condition such as battery condition.
- (B) The primary reference, McLain, briefly acknowledges that many portable devices are battery powered (col. 1 lines 22 - 28), but McLain does not disclose that their method minimizes battery energy consumption or extends battery life. Instead, McLain indicates that their method minimizes *wasted memory* (McLain col. 2 lines 15 - 16) for subsequent "offline browsing" (McClain col. 2 lines 20 -21, col.

3 lines 45 - 49).

Further, Agrawal does not teach battery life maximization using their method, either, but instead teaches *prioritizing* upload (from the mobile device to the base station) of information from the low-battery networked device in order to fully accomplish the transfers *before the battery dies* (Agarwal ABSTRACT, col. 1 lines 65 - 67). It was stated in the rationale for the rejections that Agrawal teaches using battery condition to "take action", but Agrawal only teaches using battery condition to assign higher priority to data transmissions from the low-battery device. There is no suggestion in Agrawal that battery condition should be used for broadly "taking action", and there is no suggestion to specifically select essential web objects thereby suppressing download of non-essential web objects.

- (C) Applicants' claims are directed towards restricting transfers of data *from* a server to the mobile device (e.g. "downloading"), while Agarwal's technology is directed towards the reverse transfer of information *from* the mobile station to the base station (e.g. "uploading") (Agarwal ABSTRACT, col. 1 lines 59 - 61).

Neither McLain or Agrawal, therefore, teaches or even suggests using battery condition (or a variable condition) as a parameter to determine which essential or non-essential web page objects to transmit or not transmit from a server to a networked client in order to extend battery life.

Further, Appellants pointed out that motivation or suggestion to combine and modify in the manner proposed in the rationale for the rejection does not exist. Because neither McLain or Agrawal even suggests using battery condition as a parameter to determine which essential or non-essential web page objects to transmit to a networked client in order to extend battery life, there can be no motivation to make the combination as proposed.

In response to these arguments from Appellants, it was stated in the rationale for the Final rejections (see examiner's response 2.1) that Appellants cannot attack the references individually. However, the combination of the two references must fairly teach all claimed

elements, steps, and limitations. Demonstration of missing steps, elements, and limitations was made by Appellants by considering the disclosures of each reference individually. Any element, step, or limitation which is missing from both references is also necessarily missing from the combined references.

As discussed in the foregoing paragraphs, neither reference teaches or suggests use of a battery condition to block delivery of non-essential web objects, not just re-prioritize them. Therefore, the combined McLain-Agarwal reference also fails to teach these steps, elements, and limitations.

In further response to Appellants' arguments, the examiner noted in the rationale for the Final rejections that (a) claiming provision of two sets of web objects previously designated as essential and non-essential was not supported by the specification, and (b) to interpret the claims in such a manner would improperly read the specification into the claims. The first point (a) has been addressed in the foregoing paragraphs, where clear support of this step, element, or limitation is found in the disclosure and claims as originally filed.

Regarding the second point (b), the claims are necessarily part of the specification, and therefore they are integral to the specification. For this reason, the terms in the claims must be interpreted according to the disclosure, and extrinsic definitions of terms in the claims are to be used only when the disclosure fails to provide an understanding of the terms, as the Court stated in *Phillips v. AWH Corp.* (415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)(en banc)).

Whereas the term "essential" was employed in the claims as originally filed, then the term "essential" is part of the original disclosure, and the examples of advertisements and non-advertisement web objects provide further clarification and illustration of the term.

For these reasons, Appellants request reversal of the rejections of claims 22 - 39 over McLain in view of Agarwal.

For the foregoing reasons, it is respectfully submitted that the rejections of the Final Office Action are erroneous and should be reversed. Allowance of Claims 22 - 39 is respectfully requested.

Respectfully Submitted,

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Claims Appendix
per 37 CFR §41.37(c)(1)(viii)

Clean Form of Amended Claims

Claims 1 - 21 (previously withdrawn).

Claim 22 (previously presented):

A method for preserving battery life for a portable networked client device, said method comprising the steps of:

providing a web server with at least two sets of web objects for a web page,
including at least one set of web objects previously designated as essential objects;
receiving by said web server a battery condition from a networked client device;
selecting only said essential web objects if said battery condition is low,
otherwise selecting all said web objects in both said essential set and said advertisement set; and

transmitting said selected web objects from said web server to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery.

Claim 23 (original):

The method as set forth in Claim 22 wherein said step of selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises restricting from transmission advertisement web objects.

Claim 24 (original):

The method as set forth in Claim 22 wherein said step of selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises restricting from transmission animated graphical web objects.

Claim 25 (original):

The method as set forth in Claim 22 wherein said step of selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises restricting from transmission video segment and clip web objects.

Claim 26 (original):

The method as set forth in Claim 22 wherein said step of selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises restricting from transmission sound and audio web objects.

Claim 27 (original):

The method as set forth in Claim 22 wherein said step of selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises restricting from transmission multicolor web objects.

Claim 28 (previously presented):

A computer readable medium encoded with software for preserving battery life for a portable networked client device performing the steps of:

- providing a web server with at least two sets of web objects for a web page, including at least one set of web objects previously designated as essential objects;
- receiving by said web server a battery condition from a networked client device;
- selecting only said essential web objects if said battery condition is low, otherwise selecting all said web objects; and
- transmitting said selected web objects from said web server to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery.

Claim 29 (previously presented):

The computer readable medium as set forth in Claim 28 wherein said software for selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises software for restricting from transmission advertisement web objects.

Claim 30 (previously presented):

The computer readable medium as set forth in Claim 28 wherein said software for selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises software for restricting from transmission animated graphical web objects.

Claim 31 (previously presented):

The computer readable medium as set forth in Claim 28 wherein said software for selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises software for restricting from transmission video segment and clip web objects.

Claim 32 (previously presented):

The computer readable medium as set forth in Claim 28 wherein said software for selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises software for restricting from transmission sound and audio web objects.

Claim 33 (previously presented):

The computer readable medium as set forth in Claim 28 wherein said software for selecting only essential web objects in a web page for transmission by said web server to said client device if said battery condition is low comprises software for restricting from transmission multicolor web objects.

Claim 34 (previously presented):

A system for preserving battery life for a portable networked client device comprising:
at least two sets of web objects provided to a web server, said sets comprising at least one set previously designated as essential objects;
a battery condition receiver associated with said web server and configured to receive said battery condition from said networked client device;
an object selector configured to select only essential web objects if said battery condition is low, otherwise selecting all said web objects; and
an object transmitter configured to transmit said selected web objects to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery.

Claim 35 (previously presented):

The system as set forth in Claim 34 wherein said object selector is further adapted to restrict advertisement web objects from transmission to said client device.

Claim 36 (previously presented):

The system as set forth in Claim 34 wherein said object selector is further adapted to restrict animated graphical web objects from transmission to said client device.

Claim 37 (previously presented):

The system as set forth in Claim 34 wherein said object selector is further adapted to restrict video segment and clip web objects from transmission to said client device.

Claim 38 (previously presented):

The system as set forth in Claim 34 wherein said object selector is further adapted to restrict sound and audio web objects from transmission to said client device.

Claim 39 (previously presented):

The system as set forth in Claim 34 wherein said object selector is further adapted to restrict multicolor web objects from transmission to said client device.

Evidence Appendix
per 37 CFR §41.37(c)(1)(ix)

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

Related Proceedings Appendix*per 37 CFR §41.37(c)(1)(x)*

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).